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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,761	10/29/2001	George Bradley Hobbs	10006500-1	4299

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
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EXAMINER

NGUYEN, TAN D

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/002,761	Applicant(s) HOBBS, GEORGE BRADLEY	
	Examiner Tan Dean D. Nguyen	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims Status

Claims 1, 4-18 are pending and are rejected as followed. Claims 2-3 are canceled.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 4, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by FARRELL (US 5,383,129).**

As for independent method¹ claim 1 and method² claim 13, FARRELL discloses a computer-implemented method of managing print job costs comprising the steps of:

(a) provide an electronic print job request, the request having a set of attributes (Figs. 9, 10, 11, col. 7, lines 50-65);

(b) prior to printing the print job, calculating a cost of the electronic print job using the set of attributes; wherein calculating the cost of the electronic print job includes calculating an actual consumables cost based on a set of consumable factors {see Figs. 10, 11, col. 8, lines 10-55, col. 10, lines 15-20}; and

(c) displaying the calculated cost of the print job {see col. 9, lines 20-30}.

As for **dep. claim 4** (part of 1), which further explains the consumable factors to include various cost such as media cost, binding cost, this is taught in col. 7, lines 55-65.

4. Claims 1, 4-10, 13-16, 11-12, 17-18 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over SEVCIK et al (US 6,330,542).

As for independent Method¹ claim 1, SEVCIK et al discloses a computer-implemented method of managing print job costs comprising the steps of:

(a) provide an electronic print job request, the request having a set of attributes (Figs. 4-8, 13) and displaying set of attributes (Fig. 4);

(b) prior to printing the print job, calculating a cost of the electronic print job using the set of attributes (Fig. 4, 5 (50)); wherein calculating the cost of the electronic print job includes calculating an actual consumables cost based on a set of consumable factors {see Fig. 7, the actual consumable factors are: (1) job type: postcards, (2) volume: 2500, (3) size: 6x9, etc.}

(c) displaying the calculated cost of the print job (Fig. 7, * price: ***327.76 **).

Alternatively, the using of other well known consumable factors such as paper weight, paper color, paper grade, etc., is taught by SEVCIK et al on Fig. 7 and would have been obvious to a skilled artisan to use them if desired.

As for **dep. claim 4** (part of 1), which further explains the consumable factors to include various cost such as media cost, binding cost, this is taught in Figs. 5-7.

As for **dep. claim 5**, which further explains the job printing cost to include mailing cost, this is taught in col. 9, lines 43-45, wherein, actual weight of the order is calculated based on the quantity and paper weight and computes the freight.

As for **dep. claims 6-7**, which further limit the cost to include an estimated postage cost based on set of postage determine factors, this is taught in col. 8, line 65 to col. 9, line 12, lines 43-45 (as shown on claim 5 above) which discloses regular and special postal regulations and rates or categories and the postage range for each project or each item which normally deals with the type of media, printer technology, format and or binding options.

As for **dep. claim 8**, which further deals with the step of (e) presenting a menu of printing business rules, i.e. (e1) least expensive, or (e2) highest quality, or (e3) fastest print (best turnaround time) or (e4) limited color, etc. (f) receiving a selection for the business rules, (g) modify the set of attributes to comply with the selected business rule, (h) re-calculating the cost of the printed job, and (i) displaying the re-calculated cost, these are fairly taught in Fig. 9 (90), Fig. 5-7, Fig. 5 (49: change option), Fig. 6-7, col. 9, lines 5-15, 50-67, col. 10, lines 1-20.

As for **dep. claims 9-10**, which further deals with the further limitation of receiving a selection of an overriding of one or more attributes of the modified set of attributes and further recalculating and displaying, these are fairly taught in col. 9, line 5-15, which discloses that the buyer can change any of these variables after receiving the quote and request another quote based on the new options as indicated by (5) in Figs. 4, 5 and 7. This allows the printing buyer to immediately see the impact of any specification changes on the price of the project.

As for **Independent Method² claim 11**, which has similar limitations as in Independent claim 1 and dep. claim 8, it's rejected for the same reason set forth in dep. claim 8 and in view of claim 1 above.

As for **dep. claim 12** (part of 11 above) which further comprising the displaying of the final cost, this is rejected for the same reason set forth in claim 8 above.

As for **Independent Product¹ claim 13**, which deals with a program storage device readable by a processor, tangibly embodying a program of instructions to perform the steps of Independent Method¹ claim 1 above, it is rejected over the program storage device readable by a processor, tangibly embodying a program of instructions to perform the steps of SEVCIK et al as shown in the rejection of claim 1 above (see also a brief summary at the abstract: network data processing system commercial printing software).

As for **dep. claims 14-16** (part of claim 13 above), they have similar limitations as in claims 8-10 and are rejected for the same reasons set forth in claims 8-10.

As for **Independent Product² claim 17**, which deals with a program storage device readable by a processor, tangibly embodying a program of instructions to perform the steps of Independent Method² claim 11 above, it is rejected over the program storage device readable by a processor, tangibly embodying a program of instructions to perform the steps of SEVCIK et al as shown in the rejection of claim 11 above.

As for **dep. claim 18** (part of claim 17 above), they have similar limitations as in dep. claim 12 and are rejected for the same reasons set forth in dep. claim 12.

Alternatively, the limitations of the dependent claims discloses the various well known parameters or variables for automated Internet quoting of commercial printings (including freight cost) which are fairly taught by SEVCIK et al on Figs. 2, 3, 4, 5, 6, 7, 12-18 as indicated above and the adjustment of these variables (or selection of certain/desired variables to meet certain desired conditions) are considered as optimizing operating conditions or result effective variables and the optimizing of result effective variables is considered as routine experimentation to determine optimum or economically feasible reaction conditions and would have been obvious to the skilled artisan, absent showing evidence of unexpected results. In re Aller, 105 USPQ 233.

5. Claims 5-7 are rejected (2nd time) under 35 U.S.C. 103(a) as being unpatentable over SEVCIK et al as applied to claims 1, 4, 8-10 above, and further in view of KARA (US 5,983,209).

In a similar method for determination of postal item weight by context, KARA discloses a computer-implemented method for completed estimating printing job prior to

Art Unit: 3629

printing by calculating the printing job and actual postage (freight cost) of a print job comprising the steps of:

(a) provide an electronic print job having a set of predefined electronic print job attributes that identify weight-determining factors such as type of paper, quantity of paper (volume), paper weight, printed context or printed mode {see Fig. 2, c1:20-30, c2:45-60, c6:35-45 "Attribute Information"};

(b) calculating a weight of the print job via a computer using the weight-determining factors (quantity and paper weight) {see Fig. 2 step 205, col. 8:5-15 }; and

(c) calculate a postage (freight/shipping/delivery cost/charge) for the print job using the set of predefined electronic print job attributes. {see Fig. 2, step 206, c3:45-55}. KARA mentions the benefits/advantages of his method, cited on col. 2, line 60 to col. 3, line 18, which are: (1) correct/precise amount of postage can be easily determined, (2) no need for a scale or balance, (3) determination is nearly instantaneously and automatically without a requirement of interaction of an operator, or (4) correct amount of postage prior to generation of a postal item. It would have been obvious to modify the calculating cost of the electronic printed job of SEVCIK et al by calculating an actual cost of mailing as taught by KARA for the benefits/advantages cited above.

As for dep. claims 6-7 (part of 1), which further deals with well known postage determining factors or parameters, they are also taught in KARA as shown on col. 5, lines 45-55, col. 6, lines 15-50, col. 8, lines 5-15.

Response to Arguments

6. Applicant's arguments filed 9/23/2004 have been fully considered but they are not persuasive.

Applicant's comment that SEVCIK et al does not even consider the cost of actual consumable material, i.e. the ink or actual amount of ink used, however, the limitation of "actual amount of ink used" is not in the disputed claims, especially independent claims 1, 11, 13 and 17. The current broad limitation, actual consumable factors, read over:

(1) job type: postcards, (2) volume: 2500, (3) size: 6x9, etc. as taught by SEVCIK et al on Figs 4-7, especially Fig. 7, and col. 9, lines 40-50 wherein the actual weight is based on the actual quantity and paper weight. Note that the ink weight on the sheet of a printed paper is normally very low or a negligible wt. Fraction or percentage and therefore the determination of the actual ink weight is not needed if precise measurement is not required or the difference or the error is so insignificant.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) US 6,064,838 discloses a printing system that can identify printing cost beforehand, see abstract, c12, lines 21-7, Figs. 27-32.

2) US 5,850,584 discloses a method of determining printing job costs using print job attributes, see whole document, esp. col. 3, line 63-col. 6, line 27.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

No claims are allowed.

Art Unit: 3629

9. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113 or <http://pair-direct.uspto.gov>.

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 305-7687. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/ 8335
Fee Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Information Help Line	1-800-786-9199

dtn

December 15, 2004


DEAN T. NGUYEN
PRIMARY EXAMINER